

REMARKS/ARGUMENTS

Upon entry of this Amendment, which amends Claims 1-5 and adds new Claims 8-12, Claims 1-12 remain pending in the present application.

In the April 8, 2004 Office Action, the declaration was objected to. Claim 3 was rejected under 35 U.S.C. § 112, Second Paragraph, for allegedly not providing antecedent basis for the term “second passive twin-T section”. Claim 1 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Pub. No. 2003/0087622 to Jayaraman et al. (hereinafter referred to as “Jayaraman et al.”) in view of U.S. Patent No. 3,577,179 to West (hereinafter referred to as “West”). Claim 5 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jayaraman et al. in view of West, and further in view of U.S. Patent No. 3,579,135 to Anderson. Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jayaraman in view of U.S. Patent No. 5,107,491 to Chew (hereinafter referred to as “Chew”). Claim 7 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jayaraman in view of Chew, and further in view of West. Finally, Claims 2-7 were objected to as being dependent on rejected base claims (i.e. independent Claims 1 and 6), but were indicated as being allowable if rewritten in independent form including all of the limitations of the respective base claims and any intervening claims.

Applicant respectfully requests reconsideration of the claims in view of the above amendments and the comments below.

Objection to the Declaration

On page 2 of the Office Action, the declaration was objected to for allegedly being defective. In particular, the declaration was objected to for not including the signature of the inventor, Nigel J. Tolson. For the following reasons, Applicant requests that this objection be withdrawn.

On December 11, 2003, the Office of Petitions mailed out a decision granting Applicant's petition to file the subject patent application in the absence of Mr. Tolson's signature. A copy of the of the decision granting Applicant's petition is attached to this Amendment for the Examiner's convenience. Accordingly, in light of the grant of the petition, Applicant respectfully requests that the objection to the declaration be withdrawn.

35 U.S.C. § 112, Second Paragraph, Claim Rejection – Claim 3

On page 2 of the Office Action, Claim 3 was rejected under 35 U.S.C. § 112, Second Paragraph, for allegedly not including antecedent basis for the term "second passive twin-T section". In particular, it is asserted that the "second passive twin-T section" term is not specified anywhere in Claim 3, thereby rendering the scope of the claim unascertainable. For the following reasons Applicant respectfully disagrees.

Claim 3 depends from Claim 2 and therefore includes the limitations of Claim 2. Among other claim terms, Claim 2 includes "a second passive twin-T filter section...." term. This recitation of the "second passive twin-T filter" in Claim 2 provides the antecedent basis for "the second passive twin-T section" recitation in Claim 3. Hence, there is no antecedent basis problem with use of the term "the second passive twin-T

section” in Claim 3, as suggested in the Office Action. Applicant respectfully requests, therefore, that the § 112 rejection of Claim 3 be withdrawn.

35 U.S.C. § 103(a) Claim Rejections – Claim 1 and its Dependent Claims

On pages 2-3 of the Office Action, independent Claim 1 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jayaraman et al. in view of West. For the following reasons Applicant respectfully disagrees.

M.P.E.P. § 2143.01 directs that:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Section 2143.01 further directs that:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As explained in detail below, if the Jayaraman apparatus were modified by West, the modification would not only change the principle of operation of the amplifier, it would also render the Jayaraman et al. apparatus unsatisfactory for its intended purpose. Applicant respectfully believes that because either of these results violates M.P.E.P. § 2143.01, the § 103 rejection of independent Claim 1, based on a modification of Jayaraman et al. by West, cannot be properly maintained.

Jayaraman et al. disclose methods and apparatus for detecting and mitigating adjacent channel interference (ACI). A selectable digital filter 240 (e.g. a FIR filter)

having a number of possible filter responses (e.g., provided by a number of sets of filter coefficients) is used to provide filtering of digital data samples to reject detected ACI. West discloses a low-pass elliptic-function filter including first and second passive twin-T RC networks 12. Hence the selectable filter 240 in Jayaraman et al. is a digital filter, and the twin-T RC networks 12 in West are analog filters.

Changing the digital filter in the Jayaraman et al. apparatus to an analog filter, by modifying Jayaraman et al. with West, would render the digital processing functionality of the Jayaraman et al. unsatisfactory for its intended purpose. Accordingly, because such a result is in violation of M.P.E.P. § 2143.01, Applicant believes that for at least these first reasons the § 103 rejection of independent Claim 1 cannot be properly maintained. Applicant respectfully requests, therefore, that the rejection be withdrawn.

Further, M.P.E.P. § 2143.02 directs that modifying a reference by another, and using such a modification to support a § 103 rejection, is permissible only if the modification would provide one of ordinary a reasonable expectation of success at making what is claimed. Here, it has already been pointed out that modifying the digital filter to an analog filter would render the Jayaraman et al. apparatus unsatisfactory for its intended purpose. For similar, reasons such a proposed modification would not lead to a successful manufacture of what is claimed in independent Claim 1 of the present invention. Furthermore, because both of the twin-T RC networks 12 in West are passive filters, such a modification would not successfully lead to a filter apparatus containing “a first analog active twin-T filter”, as independent Claim 1 requires.

Because the proposed modification of Jayaraman et al. by West does not provide a reasonable expectation of success, such a proposed modification is in violation of M.P.E.P. § 2143.02. For at least this second reason, therefore, Applicant respectfully

believes that the § 103 rejection of independent Claim 1 cannot be properly maintained.

Applicant respectfully requests, therefore, that the rejection be withdrawn.

Claims 2-5 all depend from independent Claim 1. Accordingly, they derive patentability as depending on what appears to be an allowable base claim. Applicant requests, therefore, that the § 103 rejections of dependent Claims 2-5 also be withdrawn.

35 U.S.C. § 103(a) Claim Rejections – Claim 6 and its Dependent Claims

Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jayaraman in view of Chew. For the following reasons, Applicant respectfully disagrees.

Chew discloses a collision filter for use in a network to detect a fault condition wherein two or more nodes are simultaneously transmitting on the network. The collision filter, similar to the filter in West, is an analog filter. As discussed above, in response to the rejection of Claim 1, modifying the digital filters in the digital Jayaraman et al. apparatus so that they are analog filters would change the principle of operation of the Jayaraman et al. apparatus, and would render the Jayaraman et al. apparatus unsuitable for its intended purpose of digital processing. Because the collision filter in Chew is also an analog filter, substantially the same reasons as to why the § 103 rejection of independent Claim 1 is improper apply to the § 103 rejection of independent Claim 6 here. For at least these reasons, Applicant respectfully requests that the § 103 rejection of independent Claim 6 cannot be properly maintained, and requests, therefore, that it be withdrawn.

Claim 7 depends from independent Claim 6. Accordingly, it derives patentability as depending from what appears to be an allowable base claim. Applicant requests, therefore, that the § 103 rejection of dependent Claims 7 also be withdrawn.

New Claims – Claims 8-12

New claims 8-12 are believed to be allowable over the cited prior art of record for at least the same or similar reasons as provided above.

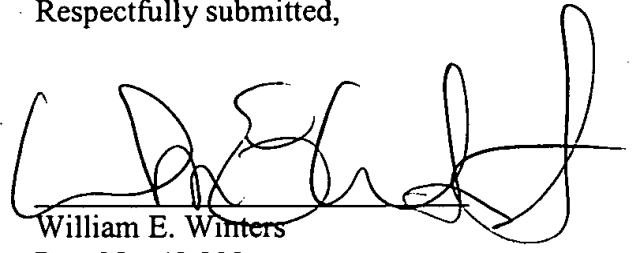
CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-282-1857.

Respectfully submitted,

Dated: JULY 8, 2004


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OFFICE OF PETITIONS

In re Application of :
Nigel J. Tolson :
Application No. 10/040,535 : DECISION ACCORDING STATUS
Filed: 28 December, 2001 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 111228TWT.US :

This is in response to the renewed petition filed by facsimile on
12 August, 2002, under 37 CFR 1.47(b).

The petition is **GRANTED**.

Petitioner has shown, via the declaration of registered patent
attorney Michael J. Ure, that a copy of the application was sent
via E-mail to the non-signing inventor. The inventor, however,
failed to sign and return the declaration naming him as the sole
inventor. Additionally, petitioners have shown proprietary
interest by providing a copy of the employment agreement between
the non-signing inventor and Rule 47(b) applicant. Lastly,
petitioner has submitted a declaration in compliance with 37 CFR
1.63 and 1.64 and has demonstrated that such action is necessary
to prevent irreparable damage.

This application and papers have been reviewed and found in
compliance with 37 CFR 1.47(b). This application is hereby
accorded Rule 1.47(b) status.

As provided in Rule 1.47(c), this Office will forward notice of
this application's filing to the non-signing inventor. Notice of
the filing of this application will also be published in the
Official Gazette.

The application file is being forwarded to Technology Center 2600
for examination in due course.

CPI
Excer
[Signature]

Application No. 10/040,535

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Telephone inquiries regarding this communication should be directed to the undersigned at 703.308.6918.

K. Mead

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Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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